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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,639	06/16/2005	Nicolas Roques	RN02174	8632

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EXAMINER	
KOSACK, JOSEPH R	
ART UNIT	PAPER NUMBER
1626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/539,639	ROQUES ET AL.	
	Examiner	Art Unit	
	Joseph Kosack	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-48* is/are pending in the application.

4a) Of the above claim(s) *36-48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 25-48 are pending in the instant application.

Election/Restrictions

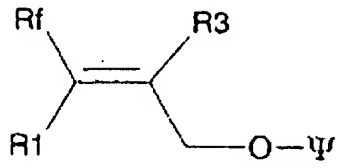
Applicant's election with traverse of a single compound, namely trifluorobutenyl acetate in the reply filed on December 27, 2006 is acknowledged. The traversal is on the ground(s) that the compounds of Formula I are novel and unobvious. This is not found persuasive because the test for unity of invention is to have a common core structure that has a contribution over the prior art. The core structure was shown in the previous action and a reference that taught that core structure was provided. Applicant has not rebutted the Examiner's determination of the core structure. Additionally, Unity of Invention is determined at each stage of an application and can be reevaluated by the Examiner.

The requirement is still deemed proper and is therefore still FINAL.

Status of the Claims

Claims 25-48 are pending in the instant application. Claims 25-35 (in part) and 36-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in the structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Pursuant to Applicant's election of a single compound, the scope of the invention will be limited to the following substitutions of the base structure



where:

- Rf is trifluoromethyl;
- R1 and R3 are hydrogen;
- Ψ with the connecting oxygen is acetate or trifluoroacetate.

Priority

The claim to priority as a 371 filing of PCT/FR03/03780 filed December 17, 2003 which claims priority to FR 02/16308 filed December 20, 2002 is acknowledged in the instant application.

Information Disclosure Statement

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other

information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Objections

Claims 25-35 are objected to for containing elected and non-elected subject matter. The elected subject matter have been identified supra.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-26, 32, and 35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites Rf to be a radical carrying a perfluoromethylene group, which group provides the link with the remainder of the molecule. It is not known what the metes and bounds of Rf is as the definition of the "link with the remainder of the molecule" cannot be found within the specification. Applicant may point out to the Examiner what is meant by the "link with the remainder of the molecule" from within the specification to assist in overcoming this rejection.

Claim 25 recites Ψ-O-H to have a pKa in water of at most 8, optionally of at most 5. The Examiner is unsure which value is intended to be protected by the claim, therefore the metes and bounds of the claim is not known and the claim is indefinite. The same analysis is used to make claims 26, 32, and 35 indefinite. Applicant may overcome this rejection by amending the claims to remove the ambiguity.

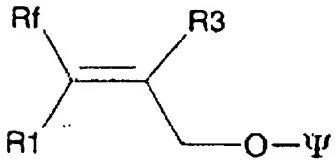
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-35 rejected under 35 U.S.C. 102(b) as being anticipated by Lewis et al. (*Journal of the American Chemical Society, 1968*, 662-668).

The instant application is drawn to compounds of the formula



where: Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ with the connecting oxygen is acetate or trifluoroacetate.

Lewis et al. teach a compound as described above where Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ with the connecting oxygen is trifluoroacetate. See page 662, Table I, Compound V.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

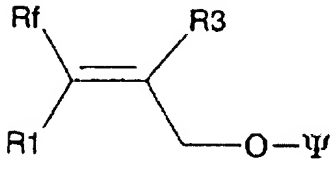
The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (*Journal of the American Chemical Society, 1968*, 662-668).

The instant application is drawn to compounds of the formula



where: Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ with the connecting oxygen is acetate or trifluoroacetate.

Determination of the scope and content of the prior art (MPEP §2141.01)

Lewis et al. teach a compound as described above where Rf is trifluoromethyl; R1 and R3 are hydrogen; and Ψ with the connecting oxygen is trifluoroacetate. See page 662, Table I, Compound V.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

Lewis et al. do not teach the compound with Rf being trifluoromethyl and Ψ with the connecting oxygen is acetate.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Lewis et al. teach various other compounds where Ψ with the connecting oxygen is acetate. See page 662, Table I, Compounds VII-XI, XVI, and XVII.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to take the compound of Lewis et al. with Ψ with the connecting oxygen is trifluoroacetate and replace the trifluoroacetate for acetate and make the claimed invention with a reasonable expectation of success. The motivation to do so is provided by Lewis et al. Lewis et al. teach that the acetate compounds are

more stable than the trifluoroacetate compounds and are less susceptible to rearrangment. See page 664.

Thus, the claimed invention as a whole was *prima facie* obviousness over the combined teachings of the prior art.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 25-35 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4-6, 8-14, and 17 of copending Application No. 10/740,802. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 25-35 directed to the same invention as that of claims 1, 4-6, 8-14, and 17 of commonly assigned Application No. 10/740,802. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this

situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Conclusion

Claims 25-35 are rejected. Claims 25-35 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 5:30 A.M. until 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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